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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,970	11/17/2003	Sundeep M. Bajikar	42.P18073	5365

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EXAMINER

SHAN, APRIL YING

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/715,970

Applicant(s)

BAJIKAR, SUNDEEP M.

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/03, 02/24/04 and 11/08/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 04/2005 and 11/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 have been examined.

Preliminary Amendment

2. Preliminary Amendments to the specification, drawings and claims are acknowledged.

Information Disclosure Statement

3. The information disclosure statement filed 25 April 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered: DE 10004164A1.
4. The information disclosure statement filed 10 November 2004 contains publications that have not been considered because they are not analogous art or within the same field of endeavor: U.S. Patent No. 5,582,717 (water cooler), U.S. Patent No. 5,720,609 (Catalytic Method for petrol), U.S. Patent No. 5,721,222 (Heterocyclic Ketons – organic biology), U.S. Patent No. 5,796,835 (Sound system enhancement – analog circuit), U.S. Patent No. 6,158,546 (Car muffler).

Specification

5. The disclosure is objected to because of the following informalities:
For example,
 - a. On page 3, line 9, missing period at the end of the sentence.

Please check the specification and fix any informality the Applicant is aware of.

Appropriate correction is required.

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use, especially with the bold items (g) Brief Summary of the invention and (h) Brief Description of the several views of the drawing(s).

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The

title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the

Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed

in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Objections

7. Claims 3 and 9 are objected to because of the following informalities:
- a. Please remove the second "(Original)" in claim 3.
 - b. For claim 9, "exchanging a encryption key" should be "exchanging an encryption key";

Please check the claims 1-24 and correct any informality the Applicant is aware of. Appropriate corrections are required.

8. Claims 14 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 14 is a system claim and it is an error for claim 14 to depend on a method claim 11. Also, claim 18 is a system claim and it is an error for claim 18 to depend on a method claim 12.

Accordingly, claim 14 is further treated on the merits depending on Examiner's best understanding on claim 14 is a dependent claim of claim 13 and claim 18 is further treated on the merits depending on Examiner's best understanding on claim 18 is a dependent claim of claim 13.

Claim Rejections - 35 USC § 112

9. Claims 14 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 14**, it is a system claim and it is an error for claim 14 to depend on a method claim 11.

As per **claim 18**, it is a system claim and it is an error for claim 18 to depend on a method claim 12.

Accordingly, claim 14 is further treated on the merits depending on Examiner's best understanding on claim 14 is a dependent claim of claim 13 and claim 18 is further treated on the merits depending on Examiner's best understanding on claim 18 is a dependent claim of claim 13.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 6-16 and 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Gehrmann et al. (U.S. Pub. No. 2004/0176071).

As per **claim 1**, Gehrman et al. discloses a method, comprising: exchanging data (steps 505 and 506 in fig. 5/steps 605 and 506 in fig. 6) between a SIM device ("subscription module" – e.g. paragraphs [0065] and [0072]. Please note in paragraph [0017], Gehrman et al. expressly define the term subscription module comprises modules which may be removably inserted into a communications terminal, such as a SIM card. Therefore, subscription module corresponds to Applicant's SIM device) and an application executed in a trusted platform (e.g. paragraphs [0065]-[0066] and [0084] – [0085]. Please note client communications terminal corresponds to Applicant's an application executed in a trusted platform), wherein the data to be exchanged is secured from unauthorized access ("...thereby providing a considerably improved security against unauthorized use of the sensitive information on the subscription module" – e.g. paragraph [0013], "After successful authentication and key exchange, the actual data exchange between the client communications terminal and the subscription module may be initiated in step 506, preferably using a symmetric encryption algorithm, as described in connection with Fig. 5.." – e.g. paragraph [0085] and "Furthermore, in order to further protect the communication between the RAA client and the subscription module, all messages sent between the entities are integrity protected, as described in connection with Fig. 5...." – e.g. paragraph [0086]).

As per **claim 2**, Gehrman et al. discloses a method as applied above in claim 1. Gehrman et al. further discloses wherein the exchanging of data include: exchanging

an encryption key via a trusted path within a computer system (e.g. paragraphs [0065] and [0084]); and exchanging data encrypted with the encryption key (e.g. paragraphs [0066] and [0085]), via an untrusted path within the computer system (e.g. paragraph [0022]).

As per **claim 3**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses wherein the exchanging the encryption key includes the application transmitting the encryption key to a protected section of memory within the computer system (e.g. paragraph [0065]); and a SIM device accessing the encryption key from the protected section of memory (e.g. paragraph [0065]).

As per **claim 4**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses wherein the exchanging the encryption key includes the application accessing the encryption key from the SIM device (e.g. paragraph [0065]), the application accessing the encryption key via a trusted port of a chipset (e.g. paragraphs [0064]-[0065]).

As per **claims 6-8 and 12**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses wherein the exchanging data includes a host controller transmitting data from the SIM device to an unprotected section of memory ("The interfaces 304 and 306 may be implemented as plug-in interfaces... such as USB or the like... as the interfaces 304 and/or 306 of the base module are open and,

thus vulnerable for unauthorized access...” – e.g. paragraph [0061]. Please note to one with ordinary skill in the art, when using USB, there is a memory section to store USB data packets, which is vulnerable for unauthorized access as disclosed by Gehrmann et al. Therefore, it met the claim limitation of unprotected memory section disclosed by the Applicant), wherein the exchanging data includes a driver transmitting data from the unprotected section of memory to the application (e.g. paragraph [0061]), wherein the host controller is a Universal Serial Bus (USB) host controller and the driver is a USB driver (e.g. paragraph [0061]) and further including: exchanging a new encryption key based on a predetermined event selected from a group comprising of, each new transaction, passage of a predetermined period of time (“...the shared secret may be a secret key which is created when needed and which is valid for a specific time period, for one session, or the like, i.e. it is a temporary shared secret” – e.g. paragraphs [0062]) and [0068]-[0071]) and exchange of a predetermined amount of data (e.g. paragraph [0062]).

As per **claim 9**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses wherein the exchanging an encryption key includes the SIM device reading the encryption key from a protected section of memory via a trusted port of a chip set (e.g. paragraph [0064]-[0065]).

As per **claim 10**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses including: the application decrypting the encrypted data using the encryption key (e.g. paragraph [0066]).

As per **claim 11**, Gehrmann et al. discloses a method as applied above in claim 2. Gehrmann et al. further discloses including prior to exchanging the encryption key, the application authenticating the SIM device (e.g. paragraph [0084] and step 604 in fig. 6).

As per **claim 13**, Gehrmann et al. discloses a system comprising: a processor ("a processing unit" – e.g. paragraph [0050]); a memory having a protected section and an unprotected section ("... The key(s) may be stored in the ROM section 203, the EPROM section 204 and/or the RAM section 205, depending on the authentication mechanism and the lifetime of the keys..." – e.g. paragraph [0060] and "...retrieves the public key(s) from its memory, e.g. a ROM or EPROM..." – e.g. paragraph [0079]. Please note ROM section 203, the EPROM section 204 and/or the RAM section 205 for storing keys corresponds to Applicant's protected section of a memory. "The interfaces 304 and 306 may be implemented as plug-in interfaces... such as USB or the like... as the interfaces 304 and/or 306 of the base module are open and, thus vulnerable for unauthorized access..." – e.g. paragraph [0061]. Please note to one with ordinary skill in the art, when using USB, there is a memory section to store USB data packets, which is vulnerable for unauthorized access as disclosed by Gehrmann et al. Therefore, it met

the claim limitation of unprotected memory section disclosed by the Applicant); a SIM device (“...a subscription module 102...the subscription module is a SIM card comprising a processing unit...” – e.g. paragraph [0050]); and a chipset to Exchange data between the SIM device and an application executed in a trusted platform (e.g. paragraphs [0065]-[0066] and [0084] – [0085]. Please note client communications terminal corresponds to Applicant’s an application executed in a trusted platform), wherein the data to be exchanged is secured from unauthorized access (“...thereby providing a considerably improved security against unauthorized use of the sensitive information on the subscription module” – e.g. paragraph [0013], “After successful authentication and key exchange, the actual data exchange between the client communications terminal and the subscription module may be initiated in step 506, preferably using a symmetric encryption algorithm, as described in connection with Fig. 5..” – e.g. paragraph [0085] and “Furthermore, in order to further protect the communication between the RAA client and the subscription module, all messages sent between the entities are integrity protected, as described in connection with Fig. 5....” – e.g. paragraph [0086]).

As per **claim 14**, Gehrmann et al. discloses a system as applied above in claim 13. Gehrmann et al. further discloses wherein the exchange of data is to include an exchange of an encryption key via a trusted path within a computer system (e.g. paragraphs [0064]-[0065] and [0084]), and an exchange of data encrypted with the

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encryption key (e.g. paragraphs [0064]-[0065] and [0085]), via an untrusted path within the computer system (e.g. paragraph [0022]).

As per **claim 15**, Gehrmann et al. discloses a system as applied above in claim 13. Gehrmann et al. further discloses wherein the exchange of the encryption key includes the application to transmit the encryption key to the protected section of memory (e.g. paragraphs [0064]-[0065]), and the SIM device to access the encryption key from the protected section of memory (e.g. paragraphs [0064]-[0065]).

As per **claim 16**, Gehrmann et al. discloses a system as applied above in claim 14. Gehrmann et al. further discloses wherein the exchange of the encryption key includes the application to access the encryption key from the SIM device (e.g. paragraphs [0064]-[0065]), the application to access the encryption key via a trusted port of a chipset (e.g. paragraphs [0064]-[0065]).

As per **claim 18**, Gehrmann et al. discloses a system as applied above in claim 13. Gehrmann et al. further discloses wherein the system includes a host controller to transmit data from the SIM device to an unprotected section of memory ("The interface 304 and 306 may be implemented as plug-in interfaces, e.g. using a standard such as USB or the like" – e.g. paragraph [0061]. The interface corresponds to Applicant's host controller).

As per **claims 19-20 and 23**, Gehrmann et al. discloses a system as applied above in claim 14. Gehrmann et al. further discloses wherein the system further includes a driver to transmit data from the unprotected section of memory to the application (e.g. paragraph [0061]), wherein the host controller is a Universal Serial Bus (USB) host controller and the driver is a USB driver (e.g. paragraph [0061]) and wherein the application is to authenticate the SIM device prior to the exchange of the encryption key (e.g. paragraph [0084] and step 604 in fig. 6).

As per **claim 21**, Gehrmann et al. discloses a system as applied above in claim 14. Gehrmann et al. further discloses wherein the SIM device is to read the encryption key from the protected section of memory via a trusted port of the chip set (e.g. paragraphs [0064]-[0065]).

As per **claim 22**, Gehrmann et al. discloses a system as applied above in claim 14. Gehrmann et al. further discloses wherein the application is to decrypt the encrypted data using the encryption key (e.g. paragraph [0066]).

As per **claim 24**, Gehrmann et al. discloses a system as applied above in claim 14. Gehrmann et al. further discloses wherein a new encryption key is to be exchanged based on a predetermined event selected from a group comprising of, each new transaction, passage of a predetermined period of time, and exchange of a predetermined amount of data (e.g. paragraph [0062]).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehrmann et al. (U.S. Pub. No. 2004/0176071).

As per **claims 5 and 17**, Gehrmann et al. discloses a method/system as applied above in claims 2 and 14. Gehrmann et al. further discloses wherein the exchanging the encryption key includes exchanging multiple encryption keys ("...multiple keys...." – e.g. paragraph [0060], "a number of secret key codes K-1 through K-N...the keys may be 128 bit symmetric keys" – e.g. paragraph [0064]), and the exchanging data includes exchanging separate units of data ("...PIN codes, authorization codes, identifiers, account numbers, all messages..." – e.g. paragraph [0066]. Please note all messages

such as PIN codes, account numbers corresponds to Applicant's separate units of data).

Gehrmann et al. does not disclose expressly each unit of data separately encrypted with an encryption key selected from the multiple encryption keys. However, Gehrmann et al. discloses in the paragraph [0062], "the shared secret may be a secret key which is created when needed and which is valid for a specific time period, for one session, or the like, i.e. it is a temporary shared secret". Therefore, multiple encryption keys can be multiple encryption session keys for encrypting multiple sessions/units of data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to encrypt each unit of data separately with an encryption key selected from the multiple encryption keys.

The motivation for doing so would have been for the RAA client and the subscription module "to have a shared secret in order to authenticate each other and to protect the communication...for a specific time period", as taught by Gehrmann et al. (Paragraph [0062]).

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1, 2 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 11, 15, 19 and 23 of copending Application No. 10/977,158 (U.S. Publication No. 2006/0075259). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2 and 13 encompass the same subject matter as claims 1, 2, 11, 15, 19 and 23 in the copending application.

Claim 1 recites a method comprising: exchanging (The term "exchanging" is interpreted as having the same meaning "transmitting..between" in the copending application) data between a SIM device and an application executed in a trusted

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platform, wherein the data to be exchanged is secured from unauthorized access (Claim 1, 15, 23 of copending application publication).

Claim 2 recites The method of claim 1, wherein the exchanging of data include: exchanging an encryption key via a trusted path within a computer system; and exchanging data encrypted with the encryption key, via an untrusted path within the computer system (Claim 2 of copending application publication).

Claim 13 recites A system comprising: a processor; a memory having a protected section and an unprotected section; a SIM device; and a chipset to Exchange data between the SIM device and an application executed in a trusted platform, wherein the data to be exchanged is secured from unauthorized access (Claims 11, 19, 23 of copending application publication).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO-892).

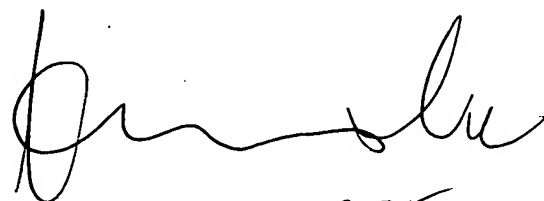
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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